



2872/\$

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application No.	09/811,081	
	Filing Date	March 16, 2001	
	First Named Inventor	Thomas W. Mossberg	
	Group Art Unit	2872	
	Examiner Name	Amari, Alessandro V.	
Total Number of Pages in This Submission	9	Attorney Docket Number	5455P001

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) Remarks	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 10px;">Return Receipt Postcard</div>

RECEIVED
OCT 24 2002
TECHNOLOGY CENTER 2800

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Kerry D. Tweet, Reg. No. 45,959 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	
Date	October 15, 2002

CERTIFICATE OF MAILING/TRANSMISSION			
I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class mail with sufficient postage in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on: October 15, 2002			
Typed or printed name	Angie C. Farr		
Signature		Date	October 15, 2002



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT (\$) 110.00

Complete if Known

Application Number 09/811,081
Filing Date March 16, 2001
First Named Inventor Thomas W. Mossberg
Examiner Name Amari, Alessandro V.
Group/Art Unit 2872
Attorney Docket No. 5455P001

METHOD OF PAYMENT (check one)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account

Deposit Account Number 02-2666
Deposit Account Name Blakely, Sokoloff, Taylor & Zafman LLP

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments
☐ Charge any additional fee(s) required under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20.
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	
SUBTOTAL (1)					(\$)

2. EXTRA CLAIM FEES

Total Claims * = X =
Independent Claims * = X =
Multiple Dependent * = X =

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
103	18	203	9	Claims in excess of 20	
102	84	202	42	Independent claims in excess of 3	
104	280	204	140	Multiple Dependent claim, if not paid	
109	84	209	42	**Reissue independent claims over original patent	
110	18	210	9	**Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$)

**or number previously paid, if greater, For Reissues, see below

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet.	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for ex parte reexamination	
112	920 *	112	920 *	Requesting publication of SIR prior to Examiner action	
113	1,840 *	113	1,840 *	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	110.00
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	
Other fee (specify)					
SUBTOTAL (3)					(\$) 110.00

* Reduced by Basic Filing Fee Paid

SUBMITTED BY

Complete (if applicable)

Name (Print/Type) Kerry D. Tweet Registration No. 45,959 Telephone (503) 684-6200
Signature [Signature] (Attorney/Agent) Date 10/15/02

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2039.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Mossberg

Serial No.: 09/811,081

Filed: March 16, 2001

For: Holographic Spectral Filter

Examiner: A. V. Amari

Group Art Unit: 2872

Attorney Docket No. 5455.P001

*6/Section
10-27-02
JSM*

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Commissioner of Patents, Washington, D.C. 20231 or:

October 15, 2002
Date of Deposit
Angie C. Farr
Name of Person Mailing Correspondence
Angie C. Farr 10-15-02
Signature Date

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO REQUIREMENT FOR RESTRICTION

PROVISIONAL ELECTION WITH TRAVERSE AND
REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT

Sir:

In response to the Office Action mailed September 10, 2002, Applicants respectfully requests that the following election be entered and the following remarks considered.

RECEIVED
OCT 24 2002
TECHNOLOGY CENTER 2800

REQUIREMENT FOR RESTRICTION

In the Office Action mailed January 29, 2002, the Examiner indicated (at page 2) that the Applicant is required to elect one of the following claim groups for prosecution:

Group	Claims	Classification
I	1-57, 87-105	Class 359, Subclass 29
II	58-86	Class 430, Subclass 1, 2

The Examiner further indicated (at page 3) that the Applicant is required to elect, for the selection claim group, a single disclosed species for prosecution. The species for the Group I and Group II claims, respectively, are indicated to be:

Group I Species	
Species 1	Claims 1-11, 26-33, 36-44
Species 2	Claims 12-25, 34, 35, 45-57
Species 3	Claims 87-103
Species 4	Claims 104 and 105

Group II Species	
Species 1	Claims 58-81
Species 2	Claims 82-86

PROVISIONAL ELECTION WITH TRAVERSE

Applicants provisionally elect, with traverse, to prosecute the claims of Group I, which group corresponds to claims 1-11, 26-33, and 36-44, as noted above. Applicants further provisionally elect to prosecute the claims of Species 2 of Group I, which includes claims 12-25, 34, 35, and 45-57.

REQUEST FOR RECONSIDERATION OF RESTRICTION REQUIREMENT

As set forth above, Applicant provisionally elects to prosecute the claims of Group I, Species 2. However, Applicant traverses the requirement for restriction and, pursuant to 37 C.F.R. § 1.143 and M.P.E.P. § 818.03, Applicant requests reconsideration of this restriction requirement for the reasons set forth below.

As set forth in M.P.E.P. § 803:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent . . . or distinct as claimed . . . ; and
- (B) There must be a serious burden on the examiner if restriction is required.

For claims directed to both a method of making a product and the product, it is further stated in M.P.E.P. § 806.05(f) that:

A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process.

Further, as set forth in M.P.E.P. § 814, the “particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be mentioned if necessary to **make the requirement clear.**” More importantly, as required by M.P.E.P. § 816, the “particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be **concisely** stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.” See also M.P.E.P. § 808.

In support of the Examiner’s restriction between the Group I and Group II claims, the Examiner suggests that “the product can be made by a materially different process

such as computer generation,” citing M.P.E.P. § 806.05(f) (reproduced above). The Examiner provides no other reasons in support of this restriction requirement.

The Applicant fails to understand how a holographic device, as described in the as-filed specification, can be made by “computer generation.” While computer-aided modeling, analysis, and drafting may be part of the design phase for many types of products and, further, although computing devices may control or assist many facets of a manufacturing process, “computer generation” is not, by itself, a method of making the described holographic device. For example, how could “computer generation” perform the act of “imprinting on at least one slab face of a substrate, a holographic pattern comprising temporal information,” as claimed in independent claim 58. By way of further example, how could “computer generation” perform the act of “depositing a layer on at least one slab face of a substrate” as recited in claim 63.

In sum, the Examiner’s reason for insisting upon restriction between Groups I and II is not clear and concisely stated, as required by the above-referenced sections of the M.P.E.P. Accordingly, the requirement for restriction is improper.


CONCLUSION

Any questions regarding this provisional election and request for reconsideration may be directed to the Applicant’s undersigned attorney.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, L.L.P.

Date: October 15, 2002


Kerry D. Tweet
Registration No. 45,959

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025
(503) 684-6200

KDT/acf